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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,111	05/22/2001	Soo-Ick Lee	678-613 (P9627)	9177

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
2645	4

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,111

Applicant(s)

LEE, SOO-ICK

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 15-17** are rejected under 35 U.S.C. 102(b) as being anticipated by Mölne (US 5,943,611).

Regarding **claim 15**, Mölne discloses a system for inputting an address book into a mobile communication terminal, the system comprising;

a mobile communication terminal (16c on FIG. 3) in communication with a mobile switching center (14c on FIG. 3);

a home location register (25c on FIG. 3) in communication with the mobile switching center; and

an address book management center (21b on FIG. 2) in communication with the mobile switching center.

Regarding **claim 16**, Mölne discloses the address book management center is comprised of a control unit and a database (column 8, lines 36-47).

Regarding **claim 17**, Mölne discloses the address book management center receives a request for information from the mobile switching center (column 8, line 62 to column 9, line 17).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-7, 9-12 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindquist et al. (US 6,687,362) in view of Miller et al. (US 6,421,707).

Regarding **claim 1**, Lindquist discloses a method of inputting an address book into a mobile communication terminal, the method comprising:

inputting, from the mobile communication terminal, an address book service number including a characteristic number allocated to a client who wants address book information, to an address book management center to supply and request the address book information (column 4, lines 53-67) [The user inputted a predetermined service code to update the address book information];

transmitting the address book service number to the address book management center (column 5, lines 1-11) [The local exchange carrier establishes a call connection with the address book updating system];

receiving the address book service number at the address book management center (column 5, lines 12-41) [The automatic address update system 101 receives the number from the user];

searching in the address book management center to retrieve the address book information corresponding to the characteristic number (column 5, lines 54-67) [The automatic address book update system 101 retrieve the relevant address book entry information].

Lindquist discloses a mobile telephone interacting with the address book center but fails to disclose transmitting and storing the retrieved address book information to the mobile communication terminal

However, Miller teaches transmitting the retrieved address book information to the mobile communication terminal (column 4, lines 40-60) [The SMS server sends notification to the mobile for any change in the system]; and

storing in the mobile communication terminal the received address book information (column 3, lines 39-51) [The personal address book information is stored in the mobile handset].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Lindquist using SMS notification system as taught by Miller.

This modification of the Lindquist invention enables the system to transmit the change in the address book so that the user would have an update address book information in the mobile phone.

Regarding **claim 2**, Miller teaches the address book management center transmits the address book information corresponding to the characteristic number in short message form to the mobile communication terminal (column 4, lines 40-60).

Regarding **claims 3 and 9**, Miller teaches confirming if the received short message is a special short message about the address book information (column 4, lines 40-60); and

automatically storing the special short message about the address book information (column 3, lines 39-51).

Regarding **claim 4**, Miller teaches the step of storing in the mobile communication terminal the received address book information further comprises updating the stored address book information, if the short message about the address book information is a short message about previously stored address book information (column 3, lines 39-51).

Regarding **claim 5**, Miller teaches transmitting from the address book management center the changed address book information to the mobile communication terminal, if there is changed information in the address book information (column 4, lines 40-60).

Regarding **claim 6**, Lindquist discloses the address book management center searches for the address book information corresponding to the characteristic number to transmit the retrieved information to the mobile communication terminal in combination with an advertisement (column 4, lines 53-67).

Regarding **claim 7**, Lindquist and Miller discloses all the limitations of claim 7 as stated on claim 1 rejection above.

Regarding **claim 10**, Lindquist and Miller discloses all the limitations of **claim 10** as stated in **claim 1** rejection.

Regarding **claim 11**, Lindquist discloses the address book information is updated and stored, if the address book information is previously stored (column 4, lines 53-67).

Regarding **claim 12**, Lindquist and Miller disclose all the limitations of **claim 12** as stated on **claim 1** rejection.

Regarding **claim 14**, Miller teaches transmitting changed information in the address book information to the mobile communication terminal, if there is changed information in the address book information (column 4, lines 40-60).

5. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lindquist in view of Miller and in further view of Hawkins et al. (US 6,516,202).

Regarding **claim 8**, Lindquist and Miller as applied to **claim 7** above differ from **claim 8**, in that it fails to disclose a password is set in the address book information requested from the mobile communication terminal, further comprises the step of confirming in the address book management center if the password is transmitted from the mobile communication terminal.

However, Hawkins teaches if a password is set in the address book information requested from the mobile communication terminal, further comprises the step of confirming in the address book management center if the password is transmitted from the mobile communication terminal (column 8, lines 66-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Lindquist using the authentication of the user as taught by Hawkins.

This modification of the Lindquist invention enables the system to verify the user as a subscriber so that the user would access the address book information using the mobile phone.

6. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lindquist in view of Miller and in further view of Gledje (US 2002/0032771).

Regarding **claim 13**, Lindquist and Miller as applied to **claim 7** above differ from **claim 8**, in that it fails to disclose transmitting an advertisement together with the retrieved information that is transmitted to the mobile terminal.

However, Gledje teaches transmitting an advertisement together with the retrieved information that is transmitted to the mobile terminal (§ 022).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Lindquist using the advertisement server as taught by Gledje.

This modification of the Lindquist invention enables the system to transmit advertisement using the SMS message notification so that the user would receive event-based advertisements.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chmaytelli et al. is cited for a search and replace features for handset phone book (FIG. 1).

Bond et al. is cited for mobile phone with adaptive user interface (FIG. 1).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
June 14, 2004

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